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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/073,598
Filing Date: February 11, 2002
Appellant(s): BEAULIEU, NICOLE

MAILED

JAN 24 2006

Group 3700

Aaron M. Peters
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 31st, 2005 appealing from the
Office action mailed September 30th, 2004.

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(1) Real Party in Interest

The brief identifies IGT, the assignee of rights in the present application as the real party in Interest.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | |
|---------|--------------|
| 6093102 | Bennett |
| 6231442 | Mayeroff |
| 6261178 | Bennett |
| 6001016 | Walker et al |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1-3, 6-8, 9, 12-14, 17-20, 23-25, 28-30, 33-35, 38-41, 43, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett (US 6,093,102).

Regarding claims 1, 7, 12, 18, 23-25, 33, 39, and 41, Bennett teaches a video slot game apparatus including a display unit capable of displaying video images (Col 3:15-25), a value input device (Fig 5 and Col 3:29-34), and a controller incorporating a processor operable connected to memory (understood as functionally required in the machine of Bennett). The controller configured so as to allow a user to place a wager on the occurrence (or equivalently start) of the wagering game (Fig 5 and Col 3:29-34), a controller selecting a gaming option automatically from a plurality of user-selectable options if the user requests the controller to do so through not selecting an option (Col 4:30-33), display a video image including a plurality of simulated wheels (Col 3:15-25), and determine the value of payout associated with the outcome of the game (Col 1:26-31).

Regarding claims 2, 3, 6, 13, 14, 17, 34, 35, 38, 43, and 45, and in addition to the above stated, Bennett teaches the default pay line selection of a center line which a player may then decide to alter using the device inputs (Col 4:28-38). The automated selection is limited to the features present in the game of Bennett, and as such is "dependent upon parameters of the selected game" by definition.

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Regarding claims 8, 19, and 40, in addition to the above stated. The game of Bennett provides the player the option of the feature inherently, as the user is not forced or required to use the feature and thus providing the user selectable option of playing a video slot machine serves as an inherent feature of the reference discussed above.

Regarding claims 9 and 20, in addition to the above stated. The game of Bennett provides the player with the option to play a wagering game and if the player so chooses to play the wagering game the controller then may be understood to select a video slot machine type of wagering game as so claimed and presented by the Bennett references above.

Regarding claim 30 in addition to the above stated. The slot machine of Bennett teaches the traditional functionality of a slot machine wherein upon the operation by the user the user is presented with a set of symbols (symbols selected by the user) which are understood as being generated by the slot machine based on laws of probability (selection of symbols by the machine) as so claimed (Col 3:5-34).

Claim Rejections - 35 USC § 103

Claims 4, 15, 26, 36, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (US 6,093,102) as applied to claims 1,12, 33, and 41 above, and in further view of Mayeroff US 6,231,442).

In addition to the above stated Bennett teaches a multi-line slot machine but is silent on the incorporation of an associated secondary game being presented to the user. Mayeroff however, teaches the use of a multi-choice bonus game associated with a primary slot machine wherein a plurality of user selectable options is presented to the user (Figure 3 & Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention have incorporated the bonus feature of Mayeroff in the multi-line slot game of Bennett in order to increase player appeal of the machine through the incorporation of a secondary game as taught by Mayeroff (Col 2:66-3:6).

Claims 5, 16, 27, 37, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (US 6,093,102 herein referred to as '102) as applied to claims 1,12, 23, 33, and 41 above, and in further view of Bennett (US 6,261,178 herein referred to as '178).

Bennett is silent regarding the use of random selection with regards to choosing the pay line on a video slot machine in the '102 reference. However The '178 reference teaches the use of randomly selected pay lines as a "mystery line" feature in a reeled slot machine (Col 2:1-30). It would have been obvious for one of ordinary skill in the art

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at the time of invention to have incorporated the mystery line feature of the '178 reference into the slot machine of the '102 reference as disclosed above in order to increase the players enjoyment through the providing of an additional means of winning.

Claims 10, 11, 21, 22, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (US 6,093,102) as applied to at least one of claims 1,12, 23, 33, and 41 above, and in further view of Walker et al (US 6,001,016 herein referred to as '016).

Bennett is silent regarding the use of the Internet as so claimed. However Walker et al does teach the inclusion of the internet for maintaining a network of slot machine servers (Col 3:60-67). It would have been obvious for one of ordinary skill in the art at the time of invention to have incorporated the internet network of Walker et al in the slot machine of Bennett in order to allow the devices of Bennett communicate service requirements over great distances or alternatively participate in pari-mutuel pool type game or alternatively allow remote monitoring of the machines.

(10) Response to Argument

A) 1)

Appellant generally contends that the Examiner has inappropriately applied prior art outside of the scope of the Appellant's presented claims, however as demonstrated below the Appellant has argued their claims of a significantly narrower scope ~~than~~ ^{less than}

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provided for in the presented claim language and hence the Examiner's interpretation should be maintained.

The Appellant argues four grounds of rejection on appeal wherein each of the presented grounds is co-reliant on the first presented grounds of rejection. As the grounds of rejection are commonly reliant on the first grounds of rejection the redress of the first grounds of rejection will treat the remaining three grounds equally.

The first grounds of rejection contains eight separate groupings of claims, where grouping each is argued with regards to the Examiner's interpretation of similar claim language. In the interest of succinctly reducing the presented groupings to the issue at hand this response is directed specifically to this common thread. Additionally, as the Appellant's arguments are commensurate in scope with claim one, claim one is used as an exemplary claim. All additional rejections should stand or fall for the same reasons.

The pertinent portion of claim 1 reads:

said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,

said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request,

The Appellant contends that the presented claim language directed to the "...receiving data relating to a request from said person..." and in turn "...making a selection

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from among said plurality of user-selectable options in response to said request,...” is equivalent to the positive selection by a person through a specific structural element. This argument however, is flawed as none of the presented claims associate the act of selection with any specific structure(s). The presented claim language only speaks to the receipt of data relating to a request and effecting a change (selection) in response to this request, but not the source, manner, or method by which this request/data is derived and thus these claim elements are in fact functional elements. It is further noted that no request by Appellant has been made up to this point in prosecution that would invoke 112 6th paragraph.

As such the controller may “receive data relating to a request” from any source including information derived from the controller itself and would also properly entail information that is derived from outside interaction or lack thereof with the controller. The present claim contains no basis for defining the manner by which the request is made and accordingly does not limit the claim to a particular embodiment wherein the requested is resultant of a positive action by the person on the device as suggested by the Appellant.

Bennett (USP 6,093,102) generally teaches a slot machine wherein a player places a wager and selects which element positions on a 3x3 matrix defining a payline or set of elements to be examined during play for a winning combination of symbols after the spin the reels (random association of game symbols with respective elements). If the player fails to indicate a payline selection the slot machine defaults to the selection of a centerline.

The presented rejection under Bennett (USP 6,093,102) provides for the claimed determination/receipt of "...data relating to a request from said person..." through presenting the user options and resultant of the user failing to select an option making a default selection for the user. Bennett sets this selection forth as

"In the embodiment of FIG. 2 the selection would default to the center line position in the event that no symbol was selected in a particular column" (102' Col 4:30-33).

Finally as a selection is made through a default in response to the lack of selection by a person it does in fact act in make a selection/determination based on the machine perceived action of the user.

By way of an example: If a school teacher were to ask a student to raise their hand if they wanted to participate in an activity, the student regardless of whether he raised his hand or not would be making a selection. Even though in one instance the student took no action (through not raising their hand) their choice/selection was defined by their ability to raise their hand rather than their action and just as importantly this ability is equally perceived by the teacher as such.

In parallel to the example above, the ability of the person to make a selection in the invention of Bennett is perceived by the machine as a student's choice to raise their hand or not and equivalently to make a selection or to not make a selection. This choice or request is perceived by the teacher and equivalently controller as "data relating to a request from said persons" and utilized to form a basis for further action "in response to said request" such as the teachers determination if there is sufficient student interest in particular activity so as to proceed with the activity. In this particular

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situation the determination by the teacher is equated to the controller's automated selection from a plurality of user selectable options.

Further, the lack of a response (or raising of a students hand) has meaning to the observing controller (teacher) in this case as the resultant behavior is measured/perceived by the observing controller (teacher) and further utilized in the later process of the observing controller (determination of sufficient interest).

Hence the Appellant's arguments fail on two related points: First the presented claims fail to set forth any elements that would so define a specific method and/or associated structure that would limit the interpretation of the claimed "request"; and Second, the breadth of the claim resultant of the first point lends the claim open to the application of Bennett as present above. For these reasons the rejection should be maintained.

Appellant's remainder arguments attempt to equate the Examiner's position to an improper standard not supported by law and hence improper, however as demonstrated by the preceding remarks, the standard proposed by applicant was not relied upon in the correlation of prior art presented and hence arguments directed to such are moot.

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A) 2-4) These rejections should be maintained for the same reasons as set forth in the Redress of section A)1).

B) through D) These rejections should be maintained for same reasons as set forth in the Redress of section A)1).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Robert Mosser

Patent Examiner

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